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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,143	12/23/2003	Thomas M. Schaub	11884 / 406701	7478
23838 7590 03/12/2009 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER				
SEE, CAROL A				
ART UNIT		PAPER NUMBER		
3696				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/743,143

Applicant(s)

SCHAUB ET AL.

Examiner

Carol See

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 6, 7, 10-13, 15-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 10-13, 15-19, 21, 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/16/2008 has been entered.

Response to Amendment

2. In response to Applicant's Arguments/Remarks filed on 11/26/2008, Examiner acknowledges addition of new independent claim 22.
3. Applicant's amendment of claim 10 overcomes the previous rejection under 35 U.S.C. 112; accordingly, that rejection is withdrawn.
4. Claims 6, 7, 10-13, 15-19 and 21-22 are currently pending in this action.

Affidavit

5. The affidavit under 37 CFR 1.132 filed 11/26/2008, accompanying a request for continued examination, has been considered and is sufficient to overcome the rejections based on the SAPR3 reference of claims 6 and 7 under 35 U.S.C. 103 and the rejection of claims 10-13, 15-19 and 21 under 35 U.S.C. 102. Accordingly, the affidavit will be entered in the prosecution record.

Claim Objections

6. Claims 6, 10, 11, 12, 16, 17 and 18 are objected to because of the following informalities:

- separate clauses of a claim must begin on separate lines and be separated by a semi-colon ";".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 is rejected as depending from claim 6.

Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible

subject matter. Here claim 6 fails to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 is rejected as depending from claim 6. Claims 11, 12, 13 and 15 are rejected as depending from claim 10.

Re claim 7, the preamble recites a system and the specification indicates that the enterprise management system is a computer system. However, the body of the claim recites a transaction manager and AVC manager, which are not specifically identified in the specification as structural components. Further, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim 10 is rendered indefinite because some of the claim language fails to positively recite method steps as indicated by the wording of the preamble - in particular, the clauses that begins "responsive to..." does not indicate a step in a method is actually occurring. The first word in the individual clauses of a method claim must indicate some action is occurring.

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Re claim 22, the claim is rendered indefinite because the meaning of "revenue manager" is unclear. Further, it cannot be discerned as to whether this is a person, a machine, or any combination of these. The preamble recites a computer system, which indicates the body of the claim will present structure or functional language. However, it is unclear as to whether "revenue manager" is a structural component.

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites a "revenue manager", which is not described in the specification.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (U.S. 6,058,375) in view of Zawadzki et al. (U.S. 7,107,268).

As to claim 6, Park discloses an enterprise management system, comprising:
a transaction manager to receive new revenue transactions posted by an organization (col. 22, lines 11-17 and col. 23, lines 7-12 and 36-47),

Park does not specifically show an Availability Control (AVC) manager, responsive to a new revenue transaction to execute an AVC rule represented by a control object, the AVC rule causing a comparison of previously-posted revenue of the organization and revenue of the new transaction with a limit to how much revenue may be posted for the control object and, if the comparison fails a relationship defined by the AVC rule, causing the transaction manager to reject the new revenue transaction

Zawadzki teaches an Availability Control (AVC) manager, responsive to a new revenue transaction to execute an AVC rule represented by a control object, the AVC rule causing a comparison of previously-posted revenue of the organization and revenue of the new transaction with a limit to how much revenue may be posted for the control object and, if the comparison fails a relationship defined by the AVC rule, causing the transaction manager to reject the new revenue transaction (col. 40, lines 21-26, col. 41, lines 52-58, showing trying to enter a new amount to a previously posted amount, comparing the new sum to the budget amount and not allowing the amount to be entered based on that comparison).

It would have been obvious to one of ordinary skill in the art to include in the system of Park the ability to make determinations about the posting of data based on various comparisons as taught by Zawadzki since the claimed invention is merely a combination of old elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106.

As such, although Zawadzki addresses the conditional language "if the comparison fails a relationship defined by the AVC rule," as discussed above, the recitation "causing the transaction manager to reject the new revenue transaction" may never occur if the condition is not met. As such, this recitation does not serve to limit the claim. Such conditional language is normally not afforded patentable weight; however, for examining purposes the condition is considered to occur.

As to claim 7, Park in view of Zawadzki shows the system of claim 6. Park further shows an AVC ledger comprising a database storing control objects and aggregations of revenue postings that are operands to the control objects, the aggregations generated for executing the AVC rule (col. 35, lines 1-9).

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

16. Claims 10-13, 15-19, 21 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Zawadzki (U.S. 7,107,268).

As to claim 10, Zawadzki shows an Availability Control (AVC) method, comprising:

responsive to a proposed postings of revenue, determining whether a revenue calculation of any control objects would use the proposed posting in a revenue calculation (col. 40, lines 21-26, col. 41, lines 52-58, showing trying to enter a new amount to a previously posted amount, the determination coming from where the amount is entered, i.e., under which budget);

executing AVC rules for each identified control object, the AVC rules testing whether the proposed postings of revenue would exceed revenue limits for the control object (col. 40, lines 21-26, col. 41, lines 52-58, showing trying to enter a new amount to a previously posted amount, comparing the new sum to the budget amount and not allowing the amount to be entered based on that comparison), and

if any AVC rule is violated by the posting and if the AVC rule identifies an error as a response thereto, blocking the posting from being admitted (col. 40, lines 21-26, col. 41, lines 52-58, showing trying to enter a new amount to a previously posted amount, comparing the new sum to the budget amount and not allowing the amount to be entered based on that comparison).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the

grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106.

As such, although Zawadzki addresses the conditional language "if any AVC rule is violated..." as discussed above, the recitation "blocking the posting from being admitted" may never occur if the condition is not met. As such, this recitation does not serve to limit the claim. Such conditional language is normally not afforded patentable weight; however, for examining purposes the condition is considered to occur.

As to claim 11, Zawadzki shows the method of claim 10. Zawadzki further shows executing comprising:

- generating a postings operand from an aggregation of previously-admitted postings values addressed by the control object (col. 41, lines 51-57, showing summing previously admitted values); and

- determining whether the postings operand satisfies a test relationship specified for the control object (col. 41, lines 51-57, showing summing previously admitted values, and not allowing a new value if that sum exceeds set value).

As to claim 12, Zawadzki shows the method of claim 10. Zawadzki further shows executing comprising:

- generating a postings operand from an aggregation of previously-admitted postings values addressed by the control object and from a new revenue posting value

(col. 41, lines 51-57, showing summing previously admitted values and a new value),
and

determining whether the postings operand satisfies a test relationship specified for the control object (col. 41, lines 51-57, showing summing previously admitted values, and not allowing a new value if that sum exceeds set value).

As to claim 13, Zawadzki shows the method of claim 12. Zawadzki further discloses storing the postings operand in a ledger storage device associated with the control object (col. 62, line 64 to col. 63, line 55, showing a computer system and storage for implementing the invention).

As to claim 15, Zawadzki shows the method of claim 10. Zawadzki further discloses performing the determining, the executing and, if necessary the blocking for each of a plurality of AVC rule sets in an enterprise management system (col. 40, lines 21-26, col. 41, lines 52-58, showing trying to enter a new amount to a previously posted amount, comparing the new sum to the budget amount and not allowing the amount to be entered based on that comparison, which is inclusive of performing theses actions for a plurality of budgets).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106.

As such, although Zawadzki addresses the conditional language "[performing] if necessary the blocking..." as discussed above, the recitation "blocking for each of a plurality of AVC rule sets..." may never occur if the condition is not met. As such, this recitation does not serve to limit the claim. Such conditional language is normally not afforded patentable weight; however, for examining purposes the condition is considered to occur.

The limitations of claims 15-19 and 21 parallel the limitations of claims 10-13 and 15 and, therefore, are rejected under the same rationale. The computer readable medium is addressed in Zawadzki (col. 62, lines 10-55).

As to claim 22, Zawadzki shows a computer system, comprising: a revenue manager, responsive to a new revenue transaction to execute rules, the rules causing a comparison of previously posted revenue added to a revenue of the new transaction with a limit to how much revenue may be posted and, if the comparison exceeds a predetermined limit, rejecting the new revenue transaction (col. 40, lines 21-26, col. 41, lines 52-58, showing trying to enter a new amount to a previously posted amount, comparing the new sum to the budget amount and not allowing the amount to be entered based on that comparison).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol See whose telephone number is (571)272-9742. The examiner can normally be reached on Monday - Thursday 6:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon, can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

Carol See
Patent Examiner
Art Unit 3696